UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,393	04/01/2004	Virinder Mohan Batra	CHA920040003US1	9578

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ART UNIT	PAPER NUMBER
1631	

MAIL DATE	DELIVERY MODE
05/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action **Before the Filing of an Appeal Brief**	Application No. 10/816,393	Applicant(s) BATRA ET AL.
	Examiner Carolyn L. Smith	Art Unit 1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>25 April 2007</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

    a) ☒ The period for reply expires <u>3</u> months from the mailing date of the final rejection.

    b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

    Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

    (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);

    (b) ☒ They raise the issue of new matter (see NOTE below);

    (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

    (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

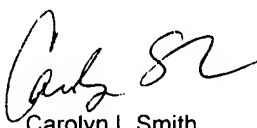   NOTE: *See Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

    The status of the claim(s) is (or will be) as follows:

    Claim(s) allowed: _____.

    Claim(s) objected to: _____.

    Claim(s) rejected: *1-20*.

    Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See Continuation Sheet.</u>

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

Carolyn L Smith
Examiner
Art Unit: 1631

U.S. Patent and Trademark Office

PTOL-303 (Rev. 08-06)   Advisory Action Before the Filing of an Appeal Brief   Part of Paper No. 20070428

Continuation of 3. NOTE: The proposed claim amendments contain "outputting" limitations which would require further consideration and/or search and appear to be NEW MATTER.

Continuation of 11. does NOT place the application in condition for allowance because: of the presence of new limitations that would require further search and/or consideration and the presence of NEW MATTER. Because the proposed amendments are not entered, all of the rejections and objection in the FINAL office action, mailed 1/25/07, are maintained.
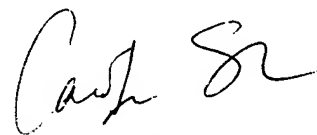
Arguments regarding the objection to the specification, 35 USC 101 rejection, and 35 USC rejections are directed to claim amendments that have not been entered and are therefore unpersuasive.

35 USC 102 rejection
Applicants argue that Rungsarityotin et al. do not disclose a "system for selectively encrypting only the coding regions identified in the nucleotide chain" because "encryption refers to the process of using an algorithm, or cipher, to apply a series of well-defined steps to plaintext information, ultimately securing or obfuscating a message. The operation of a cipher generally depends on a piece of auxiliary information, called a key, also referred to as a cryptovariable. The encryption procedure varies depending on the key, which changes the algorithm's detailed operations." This statement is found unpersuasive as the originally filed application does not provide a clear and concise definition of "encryption" which has therefore been interpreted in a broad and reasonable manner. Applicants argue that the use of a cipher to encrypt genomic data is not present in Rungsarityotin et al. This statement is found unpersuasive as the originally filed application does not provide a clear and concise definition of "cipher" which has therefore been interpreted in a broad and reasonable manner. Applicants again argue about Rungsarityotin et al. not disclosing "encryption" which has already been found unpersuasive as addressed above. Applicants additionally submit that Rungsarityotin et al. do not teach a program product including, inter alia, the feature of a "means for reassembling the coding and non-coding regions to generate a decoded nucleotide chain." (Claim 17.) This statement is found unpersuasive as Rungsarityotin et al. disclose visualizing DNA (abstract), transforming data (page 892, third and fifth paragraph), and choosing between textual and graphical output and transforming XML documents to scalable vector graphics (Figure 2 caption) which represents decrypting and regenerating/reassembling. In addition, Rungsarityotin et al. disclose data structures, software technologies, programs, storage systems, files, and databases (page 892, last four paragraphs and page 893, last paragraph) which represents a program product. Applicants argue because Figure 2 of Rungsarityotin et al. has non-coding regions represented by a line, it is not possible to reassemble the coding and non-coding region to generate a decoded nucleotide chain. This statement is found unpersuasive as "a decoded nucleotide chain" does not necessarily require that the entire chain must be decoded, so that one section of decoded chain will suffice. Applicants submit that the arguments provided above also apply to the dependent instant claims. The arguments above were already found unpersuasive and are thus unpersuasive for the dependent instant claims as well.

35 USC 103 rejection
Applicants argue that the claims are allowable based on the arguments set forth in the 35 USC 102 rejection above. This statement is found unpersuasive as the above-mentioned arguments were deemed unpersuasive for the reasons given above.

Au 1631 examiner
4/27/07